

REMARKS

Claims 35-48 are pending in the instant application. Claims 35-48 are subject to restriction.

Response to Restriction Requirement

The Examiner has required restriction to one of the following inventions:

- I. Claims 35-41, drawn to a method of preventing the development of skeletal exostosis, classified in class 514, subclass 75.
- II. Claims 42-48, drawn to a method of alleviating pain associated with the development of skeletal exostosis, classified in class 514, subclass 141.

Applicants hereby elect to prosecute the invention of Group II with traverse. For the following reasons, Applicants respectfully request that the restriction requirement be withdrawn.

There are two criteria for a proper restriction requirement between patentably distinct inventions: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803. Applicants urge that there is no serious burden in combining the restricted groups into one application.

The claims pending in the instant application relate to the use of bisphosphonates to treat horses – namely, a method of preventing skeletal exostosis and a method of alleviating pain associated with skeletal exostosis. The Examiner alleges that “these inventions...have acquired a separate status in the art because of their recognized divergent subject matter...” Applicants disagree with the Examiner’s assertion in that the two groups cited are classified in the **same** class. Also, the claims all relate to skeletal exostosis in horses. Accordingly, Applicants insist that the Examiner would not be saddled with the burden of conducting multiple searches, since all relevant art is presumably contained in class 514 and that a search of skeletal exostosis in horses would yield art related to the disease and the pain associated with it. Without such a burden, the requirements expressed in MPEP § 803 have not been satisfied, and restriction is improper.

Applicants urge that the Examiner's request for restriction in this instance is unnecessary. Applicants are not asking for unreasonable coverage of the invention or presenting unreasonably broad claims for examination.

In view of the above statements supporting lack of a serious burden on Examiner if restriction is not required, Applicants respectfully request that the requirement for restriction be withdrawn.


Response to Species Selection Requirement

The Examiner has required election of a single disclosed species "in case no generic claim is found to be allowable." Applicants hereby elect alendronate as a representative species.

Applicants note that while alendronate, cimadronate, clodronate, tiludronate, etidronate, ibandronate, neridronate, olpadronate, risedronate, piridronate, pamidronate and zoledronate are all independent species that differ structurally, they are all related in that they belong to the class of compounds known as bisphosphonates.

If a telephonic communication with the Applicants' representative will advance the prosecution of the instant application, please telephone the representative indicated below. Applicants believe no additional fees are due but the Commissioner is authorized to charge any fees required in connection with this response to Merck Deposit Account No. 13-2755.

Respectfully submitted,

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